

Office - Supreme Court, U. S.  
FILED  
APR 24 1952  
CHARLES ELMORE CROPLEY  
CLARK

~~LIBRARY~~  
~~SUPREME COURT, U.S.~~

IN THE  
**Supreme Court of the United States**

OCTOBER TERM, 1952

No. ~~24~~ 42

F. W. WOOLWORTH CO.,  
*Petitioner,*

against

CONTEMPORARY ARTS, INC.,  
*Respondent.*

---

**PETITION FOR A WRIT OF CERTIORARI TO UNITED  
STATES COURT OF APPEALS, FIRST CIRCUIT, AND  
BRIEF IN SUPPORT THEREOF**

---

MARTIN A. SCHENCK,  
KENNETH W. GREENAWALT,  
*Attorneys for Petitioner,*  
One Wall Street,  
New York 5, N. Y.

# INDEX

## PETITION FOR WRIT OF CERTIORARI:

Opinions Below .....	1
Statutes Involved .....	2
The Basis Upon Which It is Contended That This Court Has Jurisdiction .....	2
Summary Statement of the Matter Involved.....	2
The Questions Presented .....	7
Reasons Relied Upon for the Allowance of the Writ .....	8
Certificate of Counsel .....	10

## BRIEF IN SUPPORT OF PETITION FOR WRIT OF CER- TIORARI:

Statement .....	11
Point I—The decision below construes the “in lieu” clause of §101(b) of the Copyright Act in conflict with a decision of the Court of Appeals for the Second Circuit and in prob- able conflict with decisions of this Court and other Federal Courts .....	12
Point II—The decision below which sanctioned the plaintiff in departures in overall color, material, size and appearance, from its copy- righted work of art violates the provisions of the Copyright Act that infringement may only be of the work registered and is in probable conflict with decisions of this Court and of the Courts of Appeal of other Circuits. The Court below has decided a novel and important ques- tion of Federal Law which should be settled by this Court .....	17
Conclusion .....	24
Appendix A .....	25

## Table of Cases Cited

	PAGE
<i>Bentley v. Tibbals</i> , 223 F. 247, 256, 257 (C. C. A. 2, 1951) .....	21
<i>Bleistein v. Donaldson Lithographing Co.</i> , 188 U. S. 239 (1903) .....	22
<i>Bobbs-Merrill Co. v. Straus</i> , 210 U. S. 339 (1908) .....	21
<i>Davies v. Columbia Pictures Corporation of California</i> , 20 F. Supp. 809, 810 (D. C., S. D. N. Y., 1937) .....	21
<i>Davilla v. Brunswick-Balke Collender Co.</i> , 94 F. (2d) 567 (C. C. A. 2, 1938), cert. den. 304 U. S. 572 .....	14, 15, 16, 17
<i>DeJonge v. Breuker</i> , 235 U. S. 33 (1914) .....	19
<i>Douglas v. Cunningham</i> , 294 U. S. 207, 209 (1935) .....	13, 14
<i>Hoyt v. Daily Mirror</i> , 31 F. Supp. 89 (D. C., S. D. N. Y., 1939) .....	22
<i>Malsed v. Marshall Field &amp; Co.</i> , 96 F. Supp. 372 (U. S. D. C., W. D., Wash. N. D., 1951) .....	14, 15
<i>Mifflin v. R. H. White Company</i> , 190 U. S. 260, 264 (1903) .....	19
<i>New York Times Co. v. Star Co.</i> , 195 F. 110 (1912) .....	22
<i>Sammons v. Colonial Press</i> , 126 F. (2d) 341, 350 (C. C. A. 1, 1942) .....	14, 16, 17
<i>Sheldon v. Metro Goldwyn Pictures Corp.</i> , 309 U. S. 390, 399 (1940) .....	13, 14, 16, 17
<i>Universal Pictures Co. v. Harold Lloyd Corp.</i> , 162 F. (2d) 354, 378 (C. C. A. 9, 1947) .....	14
<i>West Publishing Co. v. Edward Thompson Co.</i> , 176 F. 833 (C. C. A. 2, 1910) .....	21
<i>White-Smith Music Co. v. Apollo Co.</i> , 209 U. S. 1 (1908) .....	20

### Statutes Cited

	PAGE
Revised Rules of the Supreme Court of the United States, Rule 38, Paragraph 5(b) .....	2
<b>Title 17 U. S. Code:</b>	
Section 1 .....	2, 21
Section 7 .....	2, 18, 21
Section 13 .....	2, 21
Section 101(b) .....	2, 8, 12
<b>Title 28 U. S. Code:</b>	
Section 1254(1) .....	2

IN THE  
**Supreme Court of the United States**

OCTOBER TERM, 1951

No. \_\_\_\_\_

---

F. W. WOOLWORTH CO.,  
*Petitioner,*

*against*

---

CONTEMPORARY ARTS, INC.,  
*Respondent.*

---

**PETITION FOR A WRIT OF CERTIORARI TO  
UNITED STATES COURT OF APPEALS,  
FIRST CIRCUIT**

Petitioner, F. W. Woolworth Co., prays that, in the above-entitled case involving the meaning and application of stated sections of the Copyright Act, a writ of certiorari issue to review the decision and judgment of the United States Court of Appeals, First Circuit, filed December 26, 1952.

**Opinions Below**

The opinion of the First Circuit Court of Appeals (R. 268-280) is reported in 193 F. (2d) 162. The memorandum of decision of the District Court (R. 15-25) is reported in 93 F. Supp. 739.

## **Statutes Involved**

The pertinent statutory provisions are Sections 1, 7, 13 and 101(b) of the Copyright Act (17 U.S.C.). So far as relevant, said statutes are printed in Appendix A, *infra*, pages 25-7.

## **The Basis Upon Which It is Contended That This Court Has Jurisdiction**

The jurisdiction of this Court is invoked under Title 28, United States Code, Section 1254(1) and Rule 38, paragraph 5(b) of the Revised Rules of the Supreme Court of the United States.

The opinion of the First Court of Appeals was rendered and its judgment sought to be reviewed was entered, on December 26, 1951. Petitioner's time to file this petition has been extended, by order, to and including April 24, 1952.

## **Summary Statement of the Matter Involved**

The United States Court of Appeals for the First Circuit has unanimously affirmed a judgment against defendant, petitioner herein, rendered after trial in an action in equity brought under the Copyright Act of the United States for alleged infringement of copyright on a "work of art" entitled "Cocker-spaniel in show position" published March 26, 1942, two copies thereof having been deposited in the Copyright Office on March 28, 1942 (Pl. Ex. 3; R. 252).

Plaintiff's copyright (R. 252), as the registration certificate shows, was not on a "model or design for work of art" but on a published "work of art".

The complaint alleged (R. 6) that defendant had infringed plaintiff's copyright "in said sculpture and work

of art" by reproducing and selling copies and reproductions thereof. The alleged infringing article was a ceramic statuette of a cocker-spaniel dog in show position, marked in evidence as "Plaintiff's Exhibit 1" and "Defendant's Exhibit A" (R. 28-9).

(Parenthetically it should be noted that defendant disclaimed infringement on the ground that the ceramic dog statuette sold by it (Pl. Ex. 1; Def. Ex. A) was not copied, directly or indirectly, from plaintiff's work of art copyrighted in March 1942, but was, in fact, an exact copy and reproduction of a cocker-spaniel statuette designed and modeled independently and earlier, in 1938, by a designer and craftsman named Moyer while in the employ of Burley Pottery Co. of Zanesville, Ohio, which company, in that year, manufactured and sold dog statuettes of that design and model. Defendant offered in evidence an exact plaster reproduction of the Moyer dog bearing the imprinted date "1938" (R. 135, 148-9; Def. Ex. F), but the District Court (whose hostility to defendant was manifested throughout (Cf. R. p. 11) and recognized by the Circuit Court (R. 279-80)) over defendant's objection and exception excluded testimony which would have confirmed Moyer's uncontradicted oral testimony and the age, authenticity and date of said plaster reproduction (R. 181, 202, 229, 231-40)).

On the trial, plaintiff did not offer in evidence, or in any way prove, any dog sculpture or statuette claimed to be a duplicate or copy of the work of art upon which the copyright had been obtained, but offered (as "embodying the copyright") three dog statuettes which each differed from the other but which were all claimed to be protected under that one copyright (R. 31, 50). These differences the plaintiff affirmatively proved in detail because it had alternative theories as to the manner in which defendant's supplier had made the claimed infring-

ing dog: *i.e.*, either by cutting down its larger plaster dog (Pl. Ex. 5; R. 101, 105, 109) or by building up, with plasticine, one of its two smaller porcelain dogs (Pl. Ex. 6, 7; R. 105).

Plaintiff's statuette dog, Exhibit 5, is of buff colored plaster with a spot of black on the muzzle and on each eye. It is made from a rubber mold (R. 53). There is no "demarcation" to define mouth, nose and eyes (R. 64). It sold for \$4 (R. 55). Plaintiff's statuette dog, Exhibit 6, is of red porcelain. Plaintiff's statuette dog, Exhibit 7, is of black and white porcelain. (These three exhibits were received in evidence at page 31 of the Record).

The porcelain dogs were not made from rubber molds but from plaster molds which necessitated elimination of "undercuts", and resulted in some additional alterations in the characteristics of the dog (R. 56, 61, 67, 68). The porcelain dogs are noticeably smaller than the plaster dog (R. 54).

The plaster dog is not glazed. The porcelain dogs are glazed twice and hand painted between glazes. Plaintiff's witness testified "We apply to our ceramic dog a further treatment of hand detail over the body of the glaze" and it is fired again so that the second glaze is absorbed into the first glazing (R. 54). "We apply hand detail in the eyes and on the nose" (R. 55). It requires considerable care and is "all entirely different from the coloring of the rest of the dog" (R. 56). "We would take care of the facial expression and detail in that second glazing \* \* \* the black nose, the mouth and the eyes and so forth" (R. 61). The paint is extremely difficult to work with and to give expression to eyes, nose and muzzle (R. 56).

The black and white porcelain dog has elaborate black, handpainted markings or spots skillfully indicating fur

over body, legs, ears, flanks and muzzle. The eyes are lively reddish brown with black pupils and a highlight. It sold for \$15. (R. 57).

The Court below in its opinion (R. 269) summarized some of these differences between plaintiff's dogs:

"One of the embodiments relied upon is a buff colored plaster model about nine inches long by seven inches high which sold at retail for \$4.00; another is a slightly smaller (about eight inches by six inches) red porcelain model which sold at retail for \$9.00 and the third is a hand-painted black and white porcelain model which retailed for \$15.00"

The Court below (R. 270-1), through what seems to us a drastic extension of the subject matter of copyright in respect of a statuette as a work of art, has recognized the right of the copyright holder (after copyright and without new copyright) to change at will the size, material, appearance and even the color of the statuette providing the shape is generally preserved, stating: "This does not mean stance, for show position in a dog is a standardized, stylized position which anyone is free to reproduce. It means the proportion, form, contour, configuration, and conformation, perhaps the latter in details too subtle for appreciation by anyone but a fancier, of a dog represented by the sculptured work of art."

The trial court awarded plaintiff statutory damages and the maximum amount thereof, at \$10 a copy for the first five hundred copies, under the erroneous impression that, apart from and irrespective of any proof as to plaintiff's actual damages or defendant's profits it could award such statutory damages once infringement is found. The trial court was under the misapprehension that there was a fixed yardstick of statutory damages in such a situation, to wit, \$10 per copy sold by defendant up to

the maximum amount of \$5,000, and, also, that, at plaintiff's election, it could award statutory damages in place of actual damages or profits (R. 77, 111, 113-4, 119-21, 248).

Plaintiff, from the trial's commencement, was interested in statutory damages. It made no attempt to prove any sales in its three different appearing and priced dogs at the time of or subsequent to the claimed infringement, and did not show that at that time it was selling the dog actually copyrighted or what the price of that dog was.

Defendant's profits were affirmatively proved with mathematical certainty at 59¢ on each of the 1524 dogs sold by it, or \$899.16. Defendant had given its supplier only one, original, trial order for the alleged infringing dogs in January 1949, which order was filled by deliveries to thirty-four Woolworth stores, only, in March, April and May, 1949 (R. 73-4, 123; Pl. Ex. 13). Woolworth ordered and purchased no more of such dogs thereafter (R. 74, 132). Defendant paid a price of 60¢ apiece and sold each piece for \$1.19, resulting in a profit on each piece of 59¢ (R. 73).

It was conceded that Woolworth knew nothing of plaintiff's article or copyright at the time (R. 76).

The Court below recognized that defendant's claim of error in respect of the award of statutory damages had support in the language of some of the cases "taken out of context" and that the findings of the District Court in certain respects were "clearly erroneous" but affirmed because, it held, the gross award was within the statutory limits (R. 276-7, 279).

The decision below allows a copyright holder of a work of art to change such work of art in all respects involving appearance save as to shape (wherein the continuity may be too subtle for all save the expert). The copyright

holder may nevertheless stamp his copyright notice on the varied dogs and so give false notice to the public that the changed dogs are also copyrighted. Inasmuch as the decision below specifically sanctions departures from the copyrighted article under the same copyright notice, it will result in the practical nullification and breakdown of any statutory notice of copyright in respect of statuettes. There is a resultant extension of copyright monopoly. Although these "departures" have entered into the matter of statutory damage allowed against your petitioner there is also in respect of statutory damage independent error under another section of the Copyright Act.

### **The Questions Presented**

1. Was it not error for the First Circuit Court of Appeals, on an appeal in a copyright infringement suit, to uphold the District Court's award to plaintiff of maximum statutory damages in lieu of plaintiff's actual damages and defendant's profits, where plaintiff neither proved actual damages nor difficulty or impossibility of proving such actual damages and where defendant's profits were proved with mathematical certainty?

2. Was it not error for the First Circuit Court of Appeals, by a unique method of computation of damages without statutory or judicial sanction in a copyright infringement suit, to allow, on appeal, an award of the precise amount of defendant's profits in addition to statutory damages in an arbitrary amount in order to maintain the exact amount of the District Court's award of maximum statutory damages?

3. Was it not error for the First Circuit Court of Appeals to permit plaintiff to recover, in a copyright infringement suit, without proof of its registered and

deposited statuette work of art and on the basis of three statuette models, all offered by plaintiff as "embodying the copyright", each of which was diverse as to color, size, material, markings, artistry and appearance?

4. Was it not error for the First Circuit Court of Appeals to hold that the "something irreducible" which was covered by plaintiff's copyright on a statuette work of art was shape, perhaps in details too subtle for appreciation by anyone but a fancier, and to recognize the right of the copyright holder, after copyright and without new copyright, to change and alter at will the size, material, appearance and even the color of such work of art provided the shape is generally preserved, and thus to extend the copyright monopoly and protection to such variations and adaptations of the copyrighted work?

#### **Reasons Relied Upon for the Allowance of the Writ**

1. The First Circuit Court of Appeals, in its interpretation and application of Section 101(b) of the Copyright Act and particularly the "in lieu" clause thereof, has rendered a decision in conflict with the decision of another Circuit Court of Appeals on the same matter and in probable conflict with decisions of this Court and other Federal Courts (see Point I of annexed brief, *infra*).

2. The First Circuit Court of Appeals has rendered a decision in probable conflict with the applicable decisions of this Court and other Circuit Courts of Appeal and in violation of the provisions of the Copyright Act in permitting plaintiff to recover in a copyright infringement suit without proof of the registered and deposited statuette work of art and on the basis of three statuettes,

each diverse as to color, size, materials, markings, artistry and appearance, and all offered by plaintiff as "embodying the copyright" and in thus permitting an enormous extension of copyright monopoly in the field of a statuette or sculpture copyrighted as a work of art (see Point II of annexed brief, *infra*).

3. The First Circuit Court of Appeals, as to the concept of the nature of the protection afforded by copyright to a sculpture or statuette work of art and as to the application thereof, has decided a novel and important question of Federal Copyright Law which has not been, but should be settled by this Court (see Point II of annexed brief, *infra*).

4. The questions presented here are substantial and of great importance in the interpretation and application of the Copyright Laws of the United States.

WHEREFORE, your petitioner respectfully prays that a writ of certiorari be issued directed to the United States Court of Appeals for the First Circuit in respect of its decision and judgment affirming the judgment of the District Court, District of Massachusetts, for a review thereof by this Court, and for such other relief as to this Court may seem proper.

Dated: New York, N. Y., April 23, 1952.

F. W. WOOLWORTH CO., Petitioner,

By MARTIN A. SCHENCK,  
KENNETH W. GREENAWALT,  
*Attorneys for Petitioner.*

**Certificate of Counsel**

We hereby certify that we have examined the foregoing petition for a writ of certiorari and that in our opinion it is well founded and the cause is one in which the petition should be granted.

Dated: April 23, 1952.

MARTIN A. SCHENCK,  
KENNETH W. GREENAWALT,  
*Attorneys for Petitioner.*

— IN THE  
**Supreme Court of the United States**

OCTOBER TERM, 1951

No. ....

---

F. W. WOOLWORTH CO.,  
Petitioner,  
against

CONTEMPORARY ARTS, INC.,  
Respondent.

---

**PETITIONER'S BRIEF IN SUPPORT OF PETITION  
FOR WRIT OF CERTIORARI**

**Statement**

This brief is submitted in support of the petition of F. W. Woolworth Co. for a review on writ of certiorari of the decision and judgment of the United States Court of Appeals, First Circuit, affirming the decision and judgment of the District Court of the District of Massachusetts.

A statement of the facts and questions raised is set forth in the foregoing petition and the relevant parts of the statutes involved are set forth in Appendix A hereto.

## POINT I

**The decision below construes the "in lieu" clause of §101(b) of the Copyright Act in conflict with a decision of the Court of Appeals for the Second Circuit and in probable conflict with decisions of this Court and other Federal Courts.**

The statutory basis for an award of damages in a copyright suit is set forth in Section 101(b) of Title 17 of the United States Code (formerly Section 25(b)). So far as applicable, the statute is quoted in the appendix at pages 25-6.

Plaintiff did not prove any damages and made no effort to do so. Neither did plaintiff make any showing that it was difficult or impossible to prove actual damages; and no such difficulty or impossibility existed in fact. The subject matter of the alleged infringement, to wit, one specific statuette, unlike a magazine article or story in a newspaper, presented no difficulty as to proof of damage. When given an opportunity by the Court to put in proper proof of damages, plaintiff's counsel stated: "Our reliance was on statutory damages" (R. 182-3). Plaintiff's position throughout was that its reliance was on statutory damages and that it, at its own election, had a right to statutory damages in place of and irrespective of actual damages or profits (R. 34, 182-3, 248). Furthermore, it did not show which of its three offered dog statuettes, if any, it was selling at the time of the claimed infringement. It did not prove or produce a duplicate of its copyrighted "work of art" dog nor did it show that it was selling that dog during or immediately before the period of alleged infringement or that it sold such dog in the same areas where defendant's dog was sold.

There was precise and mathematically certain and undisputed evidence of defendant's profits from its sale of the alleged infringing article. It was stipulated at the start of the trial and later testified to by the Woolworth buyer that Woolworth had purchased from its supplier as a trial order, 127 dozen dog statuettes which were distributed in 34 only of its stores; that it had paid 68¢ for each one, and had sold them at \$1.19 each for a gross profit of 39¢ per statuette or a total gross profit of \$899.16 (R. 26-27, 73-74).

It was proved, without question, that this trial order had been placed before Woolworth had knowledge of plaintiff's copyrighted work of art or notice of the alleged infringement. Plaintiff conceded Woolworth was "merely an innocent bystander" (R. 76). Woolworth did not, after placing said trial order, purchase or order any more of the alleged infringing dog statuettes (R. 74).

Despite this state of the record, the District Court awarded plaintiff statutory damages in the maximum amount of \$5,000 and made a finding that "it is difficult, if not impossible, for the plaintiff to prove its actual damages and defendant's profits, with the certainty required by the law for recovery of actual damages and profits" (R. 24). The Court of Appeals recognized that that finding was "clearly erroneous" (R. 279) but affirmed that assessment on a novel and recalculated basis which is without statutory sanction.

The District Court decision, and the decision affirming it, are in conflict with the decision of this Court in *Sheldon v. Metro Goldwyn Pictures Corp.*, 339 U. S. 390, 399 (1950), where it was held that the "in lieu" clause was not applicable where profits had been proved and to the rule stated by this Court in *Douglas v. Cunningham*, 294 U. S. 207, 209 (1935), that the statutory damage provision was adopted to afford a copyright owner relief "in a case where the

rules of law render difficult or impossible proof of damages or discovery of profits".

The decisions, below, also, are contrary to and in direct conflict with the decision of the Second Circuit Court of Appeals in *Davilla v. Brunswick-Balke Collender Co.*, 94 F. (2d) 567 (C.C.A. 2, 1938), cert. den. 304 U. S. 572, where the rule is stated to be that proof of actual profits precludes the recovery of statutory damages and that whether profits or statutory damages are to be allowed is not a matter of choice with the plaintiff. The *Davilla* case was followed by the First Circuit Court of Appeals, earlier, in *Sammons v. Colonial Press*, 126 F. (2d) 341, 350 (C.C.A. 1, 1942), wherein that Court held that the amount of profits, when established, is the measure of recovery and it will then no longer be permissible to decree statutory damages in lieu of actual damages and profits. That, also, has been stated to be the rule in the Ninth Circuit in *Universal Pictures Co. v. Harold Lloyd Corp.*, 162 F. (2d) 354, 378 (C.C.A. 9, 1947), and has been followed recently in *Malsed v. Marshall Field & Co.*, 96 F. Supp. 372 (U.S.D.C., W.D., Wash. N.D., 1951).

In *Sheldon v. Metro Goldwyn Pictures Corp.*, *supra*, this Court said (p. 399):

"We agree with petitioners that the 'in lieu' clause is not applicable here, as the profits have been proved and the only question is as to their apportionment."

In *Douglas v. Cunningham*, *supra*, this Court said (209):

"The phraseology of the section was adopted to avoid the strictness of construction incident to a law imposing penalties, and to give the owner of a copyright some recompense for injury done him, in a case where the rules of law render difficult or impossible proof of damages or discovery of profits."

In *Davilla v. Brunswick-Balke Collender Co.*, *supra*, the trial court affirmed an award of a master of \$5,000 statutory damages. The Second Circuit Court of Appeals held that "actual profits were sufficiently established before the master so as to preclude the recovery of statutory damages", reduced the \$5,000 statutory damages to \$1,057.53, defendant's profits, and stated at page 568:

"Whether profits shall be awarded or statutory damages allowed is not a matter of choice with a plaintiff."

The Court further stated at page 570:

"Since the amount of the sales was sufficiently proved, there was no basis for an award of statutory damages. Such an award should not be based upon the idea of punishment, but depends upon the absence of proof of actual profits and damages."

The recent case of *Malsed v. Marshall Field & Co.*, *supra*, is directly in point. At page 376, the Court said (italics in original):

"The 'in lieu' provision is, as the language of the section states specifically, 'in lieu of actual damages and profits'."

"It does not apply where either actual damages or profits are ascertainable.

\* \* \* \* \*

"in order that the 'in lieu' provision be resorted to, there must be difficulty or impossibility of computing both damages and profits."

The Court further stated that since profits were proved that was all plaintiff was entitled to, and that to award statutory damages would amount to imposition of a penalty.

In affirming the decision of the District Court herein, the First Circuit Court of Appeals has rendered a decision which is in conflict with an important rule of copyright law set forth in the foregoing decisions. In its decision herein (193 F. (2d) 162), the First Circuit Court recognizes that the District Court's finding that defendant's profits could not be proved or determined was "clearly erroneous" (R. 279) and that the decisions in the above cases (and in others) "lend support" to petitioner's argument that proof of actual profits precludes the assessment of statutory damages under the "in lieu" clause (R. 276-7). It disregarded the above rule of law which it had earlier stated in the *Sammons* case, following the rule stated by the Second Circuit in the *Davilla* case and by this Court in the *Sheldon* case. Instead, it appears (in a confusing statement) to have awarded plaintiff the amount of defendant's profits (\$899.16) *plus* statutory damages in the purely arbitrary amount of "\$4,100 and odd cents" (R. 279), thus maintaining the gross statutory damage award of the District Court, which had been rationalized on the basis of \$10 a copy for the first 500 copies (R. 25). By a devious process of reasoning and a novel method of calculation the First Circuit Court thus has sought to avoid the rule laid down in these prior decisions and to set up a unique rule of damages which was not intended or expressed in the copyright act and has not been stated or sanctioned, to our knowledge, by this Court or by any other Circuit Court.

The Circuit Court referred to the above cases but attempted to distinguish them on the ground that in the case at bar "plaintiff in its complaint specifically demanded, in addition to an injunction, attorney's fees and costs, both damages and profits in such amount 'as to the court shall appear proper'" (R. 277-8). It is to be noted

in both the *Sheldon* and *Sammons* cases the complaints specifically demanded both profits and damages. Also, herein on the trial plaintiff changed its pleaded position to one of reliance solely on statutory damages, rather than actual damages or profits (R. 182-3, 249). Plaintiff's attorneys, in their brief in the Circuit Court herein, admitted that the *Davilla* case squarely held that where profits were ascertainable, it was improper to award statutory damages, but argued that that case was "simply plainly wrong." (Brief for Appellee at page 42.)

The First Circuit Court in refusing to follow the *Davilla* case on this issue of statutory damages necessitates that this Court resolve the conflict between the two Circuits.

## POINT II

**The decision below which sanctioned the plaintiff in departures in overall color, material, size and appearance, from its copyrighted work of art violates the provisions of the Copyright Act that infringement may only be of the work registered and is in probable conflict with decisions of this Court and of the Courts of Appeal of other Circuits. The Court below has decided a novel and important question of Federal Law which should be settled by this Court.**

Neither Court nor petitioner's counsel have been allowed by plaintiff to see a duplicate of the "work of art" dog on which the copyright was obtained. We speculate and guess on a subject where the statute demands precision. But the three dogs, which were tendered by plaintiff on the trial as all equally "embodying the copyright", are so strikingly different that no subtlety of the sculptor's art can confuse the common sense of the ordinary observer.

The buff colored plaster dog (Pl. Ex. 5) with a black spot for muzzle and two black spots for eyes is a crude affair not worth to our mind the modest prie of four dollars. The black and white porcelain dog (Pl. Ex. 7) has its beauty given it by the double glazing with the skillful handpainting (not by Jan Allen, the sculptor, but by employees in plaintiff's shop), which simulates the fur of the dog and gives a lively expression to eyes and face and individuality by mottled black and white to the whole dog, and in our opinion is well worth the \$15. No ordinary purchaser would think that they were the same dog or under the same copyright. In fact, it is from a business standpoint plain that plaintiff after purchasing the copyright from the sculptor, Jan Allen (Pl. Ex. 4; R. 253), attempted to make the copyrighted dog in various models and forms as different as possible to appeal to different or successive markets, to each of which models and forms were added new artistic and copyrightable elements (17 U. S. Code, Sec. 7).

The Circuit Court recognizes the differences between plaintiff's three offered dogs but searches for a common denominator in all of them, in an effort to rationalize and overcome the dilemma presented by plaintiff's proofs. It supposes that a "form" is common to all three. This includes "proportion" (in this respect 9" x 7" being the same as 8" x 6") (R. 269); and "conformation" (to what, not revealed) involving details "too subtle" for common appreciation (R. 272-3). It is this element common to all three dogs and not clearly observable in any, unless at any rate they are all grouped and studied together, which defendant has been held to have infringed—and without the benefit of statutory notice or proof as to the actual dog registered.

An additional burden is cast upon defendant (along with all other merchants) as the result of what, in reality, is an enormous extension of the legalized monopoly which plaintiff (and all other holders of copyrighted statuettes) have been granted by the decision below.

The decision below is in probable conflict with decisions of this Court and also in conflict with the decisions of other Circuit Courts of Appeal which have hitherto refused, in other fields of copyright, such extensions of monopoly under the same or analogous sections of the Copyright Act. Also, the decision below in its statement and conception of the nature of the protection afforded by copyright to a statuette registered as a work of art, and in its application thereof, has decided a novel and important question of Federal Law which should be settled by this Court.

(a) Where the copyright law of February 1831 required deposit of the printed copy of the title of the book, entry of a book called "The Atlantic Monthly Magazine" did not secure copyright of "The Professor at the Breakfast Table" being published in installments therein. This Court held (*Mifflin v. R. H. White Company*, 190 U. S. 260, 264 (1903)) that the public might justly demand that the person claiming a monopoly of publication should pursue the statutory method of procuring it and that the court in determining whether a notice of copyright was misleading was not bound to look beyond the face of the notice.

In *DeJonge v. Breuker*, 235 U. S. 33 (1914), action was to restrain an alleged infringement of a copyright under the law as it was before the act of March 4, 1909. The work was a painting representing sprigs of holly, mistletoe and spruce arranged in the form of an open cluster having substantially the outline of a square. In vending it, however, the complainant reproduced it in repetitions

side by side and above and below—twelve repetitions upon strips of paper having the look of wall-paper and intended to be used in wrapping boxes. The notice of copyright was produced on each sheet but not on each reproduction of the painting. Affirming a dismissal of the complaint, this Court held that every reproduction of a copyrighted work must bear the statutory notice. In regard to the suggestion that it was over-technical to require a repetition of the notice upon every square, this Court at page 36 said:

“This argument tacitly assumes that we can look to such larger unity as the sheet possesses. But that unity is only the unity of a design that is not patented. \* \* \* The appellant is claiming the same right as if this work were one of the masterpieces of the world, and he must take them with the same limitations that would apply to a portrait, a Holy Family, or a scene of war.”

In *White-Smith Music Co. v. Apollo Co.*, 209 U. S. 1 (1908), this Court held that under the then copyright law, a “copy” of a musical composition was a written or printed record of it in intelligible notation and did not include perforated rolls to be operated in connection with a musical instrument in which they were adapted to produce the same musical notes as represented by the signs on the sheet music. This Court at page 17 stated that the common understanding of the word “copy” was “a reproduction or duplication of a thing” and quoted from an English authority that

“A copy is that which comes so near to the original as to give to every person seeing it the idea created by the original”

and on the same page this Court said that the statute had provided for the making and filing of a tangible thing

"against the publication and duplication of which it is the purpose of the statute to protect the composer."

In *Bobbs-Merrill Co. v. Straus*, 210 U. S. 339 (1908), this Court, in construing the differences between the patent and the copyright statutes, stated at page 347 that the main purpose of the copyright statutes was to secure to the author "the right to multiply copies of his work".

Under the Copyright Act (17 U.S.C. Secs. 1, 13; see Appendix A at pp. 25-7) the exclusive right granted is to copy and vend the copyrighted work, as published and deposited.

Changes and alterations in a statuette copyrighted as a work of art, just as changes in a copyrighted book in a second edition, make it a new work and necessitate a new copyright. In a copyright action, plaintiff must prove and depend solely upon the copyrighted version and cannot utilize, under the guise of "embodiments" thereof, uncopyrighted variations.

17 U. S. Code, Sec. 7 (See Appendix at p. 25);

*West Publishing Co. v. Edward Thompson Co.*,

176 F. 833 (C.C.A. 2 1910);

*Bentley v. Tibbals*, 223 F. 247, 256, 257 (C.C.A. 2 1915);

*Davies v. Columbia Pictures Corporation of California*, 20 F. Supp. 809, 810 (D.C., S.D. N.Y., 1937).

Changes in a photograph as published from the photograph as copyrighted, by "blackouts" of certain portions have been held to make the action for infringement not

maintainable. *Hoyt v. Daily Mirror*, 31 F. Supp. 89. (D.C., S.D. N.Y., 1939).

The divergencies between plaintiff's three dogs were not the subject of any dispute and the legal effects of such differences could not be determined on rulings in regard to evidence. The divergencies of the three were too great for copyright on any one of them, especially when a duplicate of the dog registered was not produced.

The divergencies affirmatively proved a failure of plaintiff to comply with the statutory conditions precedent to maintenance of an infringement suit (*New York Times Co. v. Star Co.*, 195 F. 110 (1912)).

(b) The Court below has set forth a conception of the nature of the protection afforded by copyright to a statuette work of art which is not found in any cited authority. It has held that the "something irreducible" for which such protection is afforded is a matter of "shape" and not a matter of size, material or color. The case of *Bleisten v. Donaldson Lithographing Co.*, 188 U. S. 239 (1903), which involved a copyrighted design of a circus poster, is not an authority for that proposition. There, were variations between the infringing work and the copyrighted work. Such variations were not enough to escape infringement. But in the case at bar, for the first time, so far as we have been able to ascertain, the holder of a copyright has obtained judicial approval for the making of variations in his own copyrighted work against the text of the Copyright Act and in extension of his monopoly.

Here is presented a very important question of Federal Copyright law which should be settled by this Court.

The decisions below not only hold, in effect, that the plaintiff has exclusive copyright rights in an unproven work of art entitled "Cocker-spaniel in show position",

as well as in three models of a cocker-spaniel in show position diverse in color, form, aspect, size, materials, artistry, etc., (each stated to "embody" that copyrighted work), but also holds, in effect, that plaintiff has a monopoly in the subject of a cocker-spaniel in show position in a sculpture or statuette.

The cocker-spaniel is a common dog of a particular shape. According to plaintiff's sculptress, her copyrighted work was a "composite ideal dog" based on "a lot of photographs, a lot of dogs"; it was "typical" and "representative" of "the standard of the cocker-spaniel"; she tried to "copy standards"; it was "typical of the times"; not a model of "any one particular dog"; (R. 95, 96, 102, 105, 107, 108). Plaintiff insisted that its dogs were "true" and "realistic" copies of living dogs and "true to type" and "exact" copies of prize dogs generally (R. 32, 85). Thus, their studied effort was to avoid any special treatment, uniqueness or individuality in the subject of their work of art. Ironically, therefore, this is a case where the less individuality there is in plaintiff's copyrighted dog, the broader are its claims of infringement and, under the decision below, the more extensive its granted monopoly.

Manifestly, under the decision below, no one could make or sell a statuette of a cocker-spaniel in a conventional prize position which was not substantially similar, if not identical, in shape, to any one of plaintiff's three models said to embody its copyright, to say nothing of its unproved version which was actually registered in the Copyright Office. Plaintiff is thus afforded a monopoly in breadth as to a work of art never intended by the Copyright Act.

## CONCLUSION

It is respectfully submitted, for the foregoing reasons, that the petition should be granted and that a writ of certiorari should issue to the United States Court of Appeals for the First Circuit for a review of its decision and judgment herein by this Court.

Respectfully submitted,

MARTIN A. SCHENCK,  
KENNETW. GREENAWALT,  
*Attorneys for Petitioner.*

## APPENDIX A

(Statutory provisions of the Copyright Act cited and quoted, so far as relevant, from Title 17 U. S. Code.)

### "§1. Exclusive rights as to copyrighted works

Any person entitled thereto, upon complying with the provisions of this title, shall have the exclusive right;

(a) To print, reprint, publish, copy, and vend the copyrighted work; \* \* \*

### "§7. Copyright on compilations of works in public domain or of copyrighted works; subsisting copyrights not affected

Compilations or abridgments, adaptations, arrangements, dramatizations, translations, or other versions of works in the public domain or of copyrighted works when produced with the consent of the proprietor of the copyright in such works, or works republished with new matter, shall be regarded as new works subject to copyright under the provisions of this title; but the publication of any such new works shall not affect the force or validity of any subsisting copyright upon the matter employed or any part thereof, or be construed to imply an exclusive right to such use of the original works, or to secure or extend copyright in such original works."

### "§101. Infringement

If any person shall infringe the copyright in any work protected under the copyright laws of the United States such person shall be liable:

\* \* \* \* \*

**(b) Damages and profits; amount; other remedies.**

To pay to the copyright proprietor such damages as the copyright proprietor may have suffered due to the infringement, as well as all the profits which the infringer shall have made from such infringement, and in proving profits the plaintiff shall be required to prove sales only, and the defendant shall be required to prove every element of cost which he claims, or in lieu of actual damages and profits, such damages as to the Court shall appear to be just; and in assessing such damages the court may, in its discretion, allow the amounts as hereinafter stated, \* \* \* and such damages shall in no other case exceed the sum of \$5,000 nor be less than the sum of \$250, and shall not be regarded as a penalty."

**§13. Deposit of copies after publication; action or proceeding for infringement.** After copyright has been secured by publication of the work with the notice of copyright as provided in section 9 of this title, there shall be promptly deposited in the copyright office or in the mail addressed to the register of copyrights, Washington, District of Columbia, two complete copies of the best edition thereof then published, or if the work is by an author who is a citizen or subject of a foreign State or nation and has been published in a foreign country, one complete copy of the best edition then published in such foreign country, which copies or copy, if the work be a book or periodical, shall have been produced in accordance with the manufacturing provisions specified in section 15 of this title; or if such work be a contribution to a periodical, for which contribution special registration is requested, one copy of the issue or issues containing such contribution; or if the work is not reproduced in copies for sale there shall be deposited the copy, print, photograph, or other identifying reprodu-

tion provided by section 11 of this title; such copies or copy, print, photograph, or other reproduction to be accompanied in each case by a claim of copyright. No action or proceeding shall be maintained for infringement of copyright in any work until the provisions of this title with respect to the deposit of copies and registration of such work shall have been complied with."